UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/156,886	09/18/1998	BERNHARD MUSSIG	101769-26/tesa 516.1	1668

7590 01/28/2004

Norris McLaughlin & Marcus
220 East 42nd Street
30th Floor
New York, NY 10017

EXAMINER	
GOFF II, JOHN L	

ART UNIT	PAPER NUMBER
1733	

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

A9

Office Action Summary	Application No.	Applicant(s)	
	09/156,886	MUSSIG, BERNHARD	
	Examiner	Art Unit	
	John L. Goff	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 November 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *37-55* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *37-55* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This action is in response to the request for reconsideration received on 11/15/03.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 37-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koga et al. (EP 661364) in view of Dobashi et al. (U.S. Patent 5,643,676).

Koga et al. are directed to a self-adhesive protective film for protecting the surface of a substrate (e.g. a metal substrate) from corrosion, dust deposition, or damage during transport or storage. Koga et al. teach the film comprises a backing film and an adhesive layer. Koga et al. teach the protective film is produced by co-extruding the backing film and adhesive layer. Koga et al. teach the backing film comprises a multilayer structure wherein the base layer of the film is formed of α-olefins and the layer contacting the adhesive layer is formed of α-olefins such as propylene to form a strong bond with the adhesive layer, i.e. it acts as an adhesion promoting layer. Koga et al. teach the adhesive layer comprises a plurality of α-olefinic copolymers having 2 to 12 carbon atoms and further comonomers including dienes. Koga et al. teach the diene comonomers comprise 0-50% by weight of the adhesive layer, and the diene comonomers are included for advantages such as lowering the glass transition of the adhesive layer, improving the low temperature adhesion characteristics, and providing an adjustable initial tack. Koga et al. teach the α-olefinic copolymer content is preferably 15-70 mol% of any single α-olefin. Koga et

al. teach the adhesive layer further comprises standard additives. Koga et al. further teach the protective film has a bond strength to steel of at least 20g/25mm (Page 2, lines 12-16 and 20-56 and Page 3, lines 30-36, 41-42, 45-50, 54-55 and Page 4, lines 19-21, 23-25, 30-34, and 43-46 and Page 5, lines 23-24, 33-49, 56-58 and Page 6, lines 1, 6-7, and 18-21).

Regarding claims 37, 38, and 39, Koga et al. are silent as to using the protective film for protecting the paint finish of a vehicle. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use (i.e. one of ordinary skill in the art at the time the invention was made would have readily appreciated using) the protective film taught by Koga et al. to protect the paint finish of a vehicle as it was well known in the art to use protective films such as those taught by Koga et al. to protect the paint finish of a vehicle from corrosion, dust deposition, or damage during transport or storage as shown for example by Dobashi et al.

Dobashi et al. are directed to a self-adhesive protective film which is used to temporarily protect automotive coatings during transportation and storage of automobiles. Dobashi et al. teach the protective film comprises a backing film and an adhesive layer. Dobashi et al. teach the backing film includes light stabilizers (such as HALS in an amount of 0.1 to 5% by weight) to give the protective film a UV permeability in the range from 190 to 370 nm of less than 1%, i.e. the light stabilizers improve the weatherability of the protective film (Column 1, lines 5-8 and Column 2, lines 19-25 and 59-65 and Column 3, lines 27-33 and Column 4, lines 1-10 and Column 5, lines 57-59 and Column 7, lines 5-12).

Regarding claims 37 and 42, Koga et al. are silent as to the specific Mooney viscosity of the adhesive layer. However, the adhesive composition taught by Koga et al. is the same as that

claimed, and one of ordinary skill in the art would readily expect both compositions to have the same Mooney viscosity.

Regarding claims 41, 45, 46, and 50, Koga et al. are silent as to the backing film including light stabilizers. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the backing film taught by Koga et al. light stabilizers as it was well known in the art to include light stabilizers in the backing film to improve its weatherability as shown for example by Dobashi et al.

Response to Arguments

4. Applicant's arguments filed 11/15/03 have been fully considered but they are not persuasive. Applicant argues "The Examiner concedes that Koga does not teach the criticality of the diene component when he states that "the dienes comprise 0-50% by weight of the adhesive layer (emphasis added)." The Examiner also concedes that Koga is "silent as to using the protective film for protecting the paint finish of a vehicle." Accordingly, the issues, insofar as obviousness is concerned are two-fold: First, has Applicant demonstrated the criticality of the diene component? Second, even assuming for the sake of argument that Koga suggested Applicant's film, is there anything in the combination of references that would have suggested the surprising results obtained when utilizing Applicant's protective film to protect the paint finish of a vehicle?"

It is noted applicants results show including a diene component in the adhesive produces a protective film that is removed from a substrate without defect. However, as described above Koga et al. teach the adhesive includes a diene component wherein the diene component

comprises 0-50% by weight of the adhesive layer. Furthermore, Koga et al. teach including the diene component for advantages such as lowering the glass transition of the adhesive layer, improving the low temperature adhesion characteristics, and providing an adjustable initial tack such that the inclusion of a diene component in the adhesive is obvious for these reasons/benefits given by Koga et al. As to using the protective film taught by Koga et al. to protect the paint finish of a vehicle, as described above Koga et al. disclose a self-adhesive protective film for protecting the surface of a substrate such as coated metal plates from corrosion, dust deposition, or damage during transport or storage. Koga et al. are silent as to particular products that are "coated metal plates". However, "coated metal plates" encompass the paint finish of a automobile. Furthermore, Dobashi et al. is cited as a specific showing of the well known use of self-adhesive protective films such as those taught by Koga et al. to temporarily protect the paint finish of a automobile during transportation and storage of the automobiles such the an obvious use for the self-adhesive protective film taught by Koga et al. would have been to protect the paint finish of an automobile as exemplified by Dobashi et al.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571) 272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

John L. Goff
January 23, 2004

JEFF H. APTERGUT
PRIMARY EXAMINER
GROUP 1300